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4

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,109	03/12/2004	Manfred Brinkmann	7426	7615
7590 07/02/2004 Gauthier & Connors, LLP Suite 3300 225 Franklin Street Boston, MA 02110			EXAMINER SHAKERI, HADI	
			ART UNIT 3723	PAPER NUMBER

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/799,109

Applicant(s)

BRINKMANN, MANFRED

Examiner

Hadi Shakeri

Art Unit

3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 03122004
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

Art Unit: 3723

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the pad (18) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Further "the webs adjoining the lateral marginal regions", the "threaded stud of the hub" and "internal hub extending over the width of the rotary tool fashioned as a centering cone or equipped with a conical centering bushing" as recited in the claims. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d).

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Art Unit: 3723

Specification

2. The disclosure is objected to because of the following informalities: the specification as originally filed does not provide sufficient disclosure to support the claims as recited, however, 112; 1st rejection is not applied, because the excluded description seems to be admitted prior art, e.g., the types of the rotary tool as claimed in claims 7-10.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 1 recites the limitation "the axial direction" in line 1. There is insufficient antecedent basis for this limitation in the claim.

6. Regarding claim 1, the language as recited renders the claim indefinite, for failing to set the scope of claim. It appears that the first three lines describe a prior art rotary tool, and the wherein clause, does not positively recite any structures, only that a locking unit "can" be mounted on the pad.

7. Claim 3 recites the limitation "the lower lateral marginal regions" in line 2. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 4 recites the limitation "each lateral margin region" in line 1. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 5 recites the limitation "each locking unit" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 3723

10. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 7 recites the broad recitation mechanical connectors, and the claim also recites preferably a screw which is the narrower statement of the range/limitation.

11. The above rejection, i.e., range within a range, also applies to claims 9 and the preamble in claim 1.

12. Claim 8 recites the limitation "on each of the mutually averted sides" in the last line. There is insufficient antecedent basis for this limitation in the claim.

13. Regarding claim 10, the language as written, i.e., "over the width or approximately over the entire width...as a centering cone or equipped with...", for making the scope unclear.

14. The term "such that there is a minimum clearance", as recited in line 2 of claim 11 is a relative term which renders the claim indefinite. The minimum clearance is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Art Unit: 3723

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 1-11 (as best understood) are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of Jennings (5,423,719).

Applicant's admitted prior art, e.g., pages 1-3, meets all of the limitations of above claims, including the different types of rotary sanding tools, e.g., pads detachably connected to the tool, double or single segmented sanding wheels, and pads made of elastic materials, except for locking units or mechanism to detachably couple the sanding segments to the pad. Jennings teaches abrading tools wherein the cutting inserts are detachably locked to the working face. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the invention of AAPA with detachable locking means as taught by Jennings to adapt the tool for ease of maintenance and service. Note that without a proper set up defining the axial movement with respect to the tool, any movement is considered to meet the limitation.

Regarding claims 2, 3/1, 3/2, 4/3/1, 4/3/2, prior art (AAPA in view of Jennings) meets the limitations, e.g., locking cage (24); profiles (42) and webs (52), as best understood.

Regarding claims 5 and 6, prior art (AAPA in view of Jennings) meets the limitations, e.g., rings in AAPA to secure the pad to the spindle.

Regarding claim 11, prior art (AAPA in view of Jennings) meets the limitations as best understood.

Art Unit: 3723

Conclusion

17. Prior art made of record and not relied upon are considered pertinent to applicant's disclosure. Sexton et al., Kawata et al., Becker et al., Tanigawa, Haracz and Harris, Jr. are cited to show related inventions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hadi Shakeri whose telephone number is 703-308-6279. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph J. Hail, III can be reached on 703-308-2687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Hadi Shakeri
Primary Examiner
Art Unit 3723
June 28, 2004